UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,982	07/17/2003	Kevin Chan	4366-124	2989

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EXAMINER
WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
2155	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/622,982	CHAN ET AL.
	Examiner	Art Unit	
	Liang-che Alex Wang	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1)☒ Responsive to communication(s) filed on *16 January 2007*.
- 2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
- 3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4)☒ Claim(s) *1-49* is/are pending in the application.
  - 4a) Of the above claim(s) *32-35* is/are withdrawn from consideration.
- 5)☐ Claim(s) _____ is/are allowed.
- 6)☒ Claim(s) *1-31 and 36-49* is/are rejected.
- 7)☐ Claim(s) _____ is/are objected to.
- 8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9)☐ The specification is objected to by the Examiner.
- 10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)☐ All   b)☐ Some * c)☐ None of:
    - 1.☐ Certified copies of the priority documents have been received.
    - 2.☐ Certified copies of the priority documents have been received in Application No. _____.
    - 3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  - * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1)☐ Notice of References Cited (PTO-892)
- 2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/16/2007*.
- 4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
- 5)☐ Notice of Informal Patent Application
- 6)☐ Other: _____.

DETAILED ACTION

1. Claims 1-31, 36-49 are presented for examination.

2. Claims 2, 7, 18 and 38 are amended.

Response to Arguments

3. Applicant's arguments filed 1/16/2007, have been fully considered but they are not persuasive.

4. In that remarks, applicant's argues in substance: The cited references fails to teach or suggest:

    a. the use of restriction identifiers to prevent electronic mail distribution to a recipient designated by the sender (page 14 lines 4-5);

    b. the use of restriction identifiers to prevent access of electronic mail from a set of communication devices otherwise associated with a recipient (page 14 lines 5-6);

    c. the use of restriction identifiers to limit the ability of an electronic mail recipient to forward the received electronic mail to others (page 14 lines 6-8);

    d. age limit, timestamps (page 14, lines 20-24)

    e. forwarding restriction on message itself (page 14 lines 24-27)

In response to argument (a), content in item 524 figure 9 and Col 12 lines 59-65, shows the restriction criteria in the original message of a sender.

In response to argument (b), the restriction identifier in figure 9, filters out the recipients that is matching the restriction identifier which is preventing access of message a set of

communication devices otherwise associated with a recipient (Col 3 lines 17-22; Col 5 lines 47-49; Col 12 lines 59-65).

In response to arguments (c) and (e), Olivier teaches the email message with a restriction identifier, and Canale suggests the forwarding restriction features to be added to Olivier. Olivier in combination with Canale teaches the limitation of forwarding restriction on message itself.

In response to argument (d), Col 18 lines 54-64 teaches the system cleans up the expired message which is viewed as the age limit. And timestamp must exists for expiration checkups.

Paper Submitted

5. It is hereby acknowledged that the following papers have been received and placed of record in the file:

    a. **Information Disclosure Statements** as received on 1/16/2007.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3, 5-8, 10, 11, 13-17, 19, 21-24, 26, 27, 29-31, 36, 37, 39, 41-44, 46, 47, 49 are

rejected under 35 U.S.C. 102(e) as being anticipated by Olivier, US Patent Number

6,480,885, hereinafter Olivier.

8. Referring to claim 1, Olivier teaches a method for processing an electronic message (Col

3 lines 17-22), comprising:

  a. receiving a message from a sender (Col 5 lines 33-35), the message comprising at

   least one recipient to receive the message (Col 5 lines 33-40) and including at

   least one for a restriction identifier (Col 5 lines 17-46, any acceptance criteria

   parameters could be a restriction identifier) identifying a subset of recipients from

   among a set of possible recipient (recipients on the mail list before filtering by the

   acceptance criteria; Col 3 lines 17-22) and access restriction indicating a subset of

   points of access (Col 5 lines 23-26, Col 12 lines 59-65, other acceptance criteria)

   from among a set of points of access to access the message (Col 5 lines 17-22);

  b. determining whether each identified at least one recipient is within the subset of

   recipients corresponding to the restriction identifier (step 212, Col 5 lines 40-46;

   and wherein at least one of the following steps is performed:

   I.   when the message comprises the restriction identifier and an

        identified at least one recipient is not within the subset of recipients,

        at least one of not providing access to the message to the identified at

        least one recipient who is not in the subset of recipients (Col 3 lines

        17-22; Col 5 lines 47-49, the recipients that are filtered out

        corresponds to providing access to the message to the identified at

least one recipient who is not in the subset of recipients) and

notifying the sender that an identified at least one recipient is not

within the subset of recipients; and

II.   when the message comprises the access restriction and identified at

least one recipient attempts to access the message from a point of

access not within the subset of points of access, not providing access

to the message to the identified at least one recipient whose point of

access is not within the subset of points of access (Col 3 lines 17-22;

Col 5 lines 47-49).

9. Referring to claim 3, Olivier teaches the method of claim 1, wherein the message

comprises the restriction identifier and the restriction identifier is located in a body of the

message (figure 9, Col 12 lines 59-65).

10. Referring to claim 5, Olivier teaches the method of claim 1, wherein the message

comprises the restriction identifier and the restriction identifier is located in an

attachment to the message (Col 12 lines 65-67).

11. Referring to claim 6, Olivier teaches the method of claim 1, wherein the message is

received by a server associated with at least one recipient from a server associated with

the sender (Col 5 lines 6-8, 33-45).

12. Referring to claim 7, Olivier teaches the method of claim 1, wherein the at least one of

the restriction identifier and a access identifier is configured as a flag (figure 9).

13. Referring to claim 8, Olivier teaches the method of claim 1, wherein the message

comprises the restriction identifier and wherein, when an identified at least one recipient

is not within the subset of recipient, the step of not proving access to the message to the

identified at least one recipient who is not in the subset of recipients is performed (Col 3

lines 17-22; Col 5 lines 47-49).

14. Referring to claim 10, Olivier teaches the method of claim 1, wherein the message

comprises an age restriction, the age restriction specifying an age limit of the message

(Col 14 lines 23-28).

15. Referring to claim 11, Olivier teaches the method of claim 1, wherein the message

comprises a timestamp indicating when a life of a message starts and further comprising:

comparing the expired life of the message with the age restriction to determine whether

or not to delete and/or deliver the message to the at least one recipient (Col 14 lines 23-

28, Col 18 lines 54-64.)

16. Referring to claim 13, Olivier teaches the method of claim 1, wherein the message

comprises the access restriction (Col 5 lines 18-22).

17. Referring to claims 14, 15, claims 14, 15 encompass the same scope of the invention as

that of the claim 1.   Therefore, claims 14, 15 are rejected for the same reason as the

claim 1.

18. Referring to claim 16, Olivier teaches a method for processing an electronic message,

comprising: receiving at least part of a message inputted by a user, the at least part of a

message comprising at least one recipient to receive the message (Col 5 lines 33-45);

receiving, from the user, a restriction identifier for the at least part of a message, the

restriction identifier identifying a subset of recipients from among a set of possible

recipients (Col 5 lines 23-45); and when a restriction identifier is received, tagging the message with the restriction identifier (figure 9, Col 12 lines 59-66).

19. Referring to claim 17, Olivier teaches the method of claim 16, wherein, before the message is sent to the at least one recipient, further comprising: determining whether each identified at least one recipient is within the subset of recipients corresponding to the restriction identifier (Col 3 lines 17-22); and when an identified at least one recipients is not within the subset of recipients, at least one of not providing access to the message to the identified at least one recipient who is not in the subset of recipients (Col 3 lines 17-22; Col 5 lines 47-49, the recipients that are filtered out corresponds to providing access to the message to the identified at least one recipient who is not in the subset of recipients) and notifying the sender that an identified at least one recipient is not within the subset of recipients.

20. Referring to claim 19, Olivier teaches the method of claim 16, wherein the message comprises the restriction identifier and the restriction identifier is located in a body of the message (figure 9, Col 12 lines 59-65).

21. Referring to claim 21, Olivier teaches the method of claim 16, wherein the message comprises the restriction identifier and the restriction identifier is located in an attachment to the message (Col 12 lines 65-67).

22. Referring to claim 22, Olivier teaches the method of claim 17, wherein the message is received by a server associated with at least one recipient from a server associated with the sender (Col 5 lines 6-8, 33-45).

23. Referring to claim 23, Olivier teaches the method of claim 17, wherein the restriction identifier is configured as a flag (figure 9).

24. Referring to claim 24, Olivier teaches the method of claim 17, wherein, when an identified at least one recipient is not within the subset of recipient, the step of not proving access to the message to the identified at least one recipient who is not in the subset of recipients is performed (Col 3 lines 17-22; Col 5 lines 47-49).

25. Referring to claim 26, Olivier teaches the method of claim 17, wherein the message comprises an age restriction, the age restriction specifying an age limit of the message (Col 14 lines 23-28).

26. Referring to claim 27, Olivier teaches the method of claim 17, wherein the message comprises a timestamp indicating when a life of a message starts and further comprising: comparing the expired life of the message with the age restriction to determine whether or not to delete and/or deliver the message to the at least one recipient (Col 14 lines 23-28, Col 18 lines 54-64.)

27. Referring to claim 29, Olivier teaches the method of claim 17, wherein the message comprises an access restriction indicating a subset of points of access from among a set of points of access to access the message (Col 5 lines 18-22), and further comprising when an identified at least one recipient is not within the subset of points of access, not proving access to the message to the identified at least one recipient whose point of access is not in the subset of points of access (Col 3 lines 17-22; Col 5 lines 47-49).

28. Referring to claims 30, 31, 36, 37, 39, 41-44, 46, 47, 49, claims 30, 31, 36, 37, 39, 41-44, 46, 47, 49 encompass the same scope of the invention as that of the claims 16, 17, 19, 21-

24, 26, 27, 29.   Therefore, claims 30, 31, 36, 37, 39, 41-44, 46, 47, 49are rejected for the

same reason as the claims 16, 17, 19, 21-24, 26, 27, 29.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained·though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

30. Claims 2, 4, 18, 20, 38, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Olivier in views of Clarke et al., US Publication Number 2003/0065727A1, hereinafter

Clarke.

31. Referring to claims 2, 4, 18, 20, 38, 40, Olivier teaches the method and system of claims

1, 16 and 36, wherein the message comprises the restriction identifier and the restriction

identifier is embedded within the original email message (Col 12 lines 59-63, figure 9,

block 524).

Olivier does not explicitly teaches the restriction identifier is located in a header

or in a trailer of the message.

However, Clarke teaches other information can be incorporated in any part of

email message, such as the subject line or message field (page 4 [0043]).

It would have been obvious to a person with ordinary skill in the art at the time·

the invention was made to have Clarke's method of include information into any part of

email to be incorporated with Olivier's restriction identifier such that to have the

restriction identifier to be possibly included in any part of message because both Clarke and Olivier teaches inserting information into an electronic message (Clarke, page 4 [0043]; Olivier Col 12 lines 59-63).

A person with ordinary skill in the art would have been motivated to make the modification to Olivier because having the restriction identifier to be possibly included in any part of email would facilitate proper handling of the customer's message in different system as taught by Clarke (Page 4 [0043] lines 3-6]).

32. Claims 9, 25, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier in views of Tsuei, US Patent Number 6,654,779, hereinafter Tsuei.

33. Referring to claim 9, 25, and 45, Olivier teaches the method and system of claims 1, 17 and 36, when an identified at least one recipient is not within the subset of recipients, not providing access to the message identified at least one recipient (Col 3 lines 17-22; Col 5 lines 47-49, the recipients that are filtered out corresponds to providing access to the message to the identified at least one recipient who is not in the subset of recipients).

Olivier does not explicitly teaches the notifying the sender that an identified at least one recipient is not within the subset of recipients.

However, Tsuei teaches notifying the sender if the message could not be delivered to the recipient (Col 10 lines 7-11).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to incorporate Tsuei's method of notifying recipients if the message could not be delivered with Olivier such that the sender would be notified when the message in Olivier's system is undeliverable to the filtered recipients, because both

Tsuei and Olivier teaches methods of handling email messages (Tsuei, Col 10 lines 7-11;

Olivier Col 3 lines 18-22).

A person with ordinary skill in the art would have been motivated to make the

modification to Olivier because having the sender notified when the recipient are not

receiving the message would allow sender to be aware of the fact that the communication

is not established to the recipient as taught by Tsuei (Col 10 lines 7-11).

34. Claims 12, 28, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier

in views of Canale et al, US Patent Number 5,619,648, hereinafter Canale.

35. Refering to claims 12, 28 and 48, Olivier teaches the method and system of claims 1, 17

and 36, wherein the message comprises the restriction identifier (Col 5 lines 15-46).

Olivier does not teach a restriction indicating at least one of (a) whether the

message may be forwarded and (b) to whom the message may be forward.

However, Canale teaches a forwarding restriction indicating to whom the message

may be forwarded (Col 3 line 54 – Col 4 line 8).

It would have been obvious to a person with ordinary skill in the art at the time

the invention was made to incorporate a forwarding restriction of Canale in Olivier such

that the sender would have the option to automatically forward a message, because both

Canale and Olivier teaches methods of handling email messages (Canale Col 3 lines 36-

55; Olivier Col 3 lines 18-22).

A person with ordinary skill in the art would have been motivated to make the

modification to Olivier because having the forwarding restriction would allow sender to

allow message forwards to be complete automatically as taught by Canale (Col 4 lines -

9).

Conclusion

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the mailing date of this final action.

38. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Liang-che Alex Wang whose telephone number is (703)

305-3391. The examiner can normally be reached on Monday thru Friday, 8:30 am to

5:00 pm.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang
February 1, 2007

SALEH NAJJAR
SUPERVISORY PATENT EXAMINER